

**REMARKS**

Claims 1-8 are pending in the above-identified application. It is noted that these claims correspond to the second Amendment filed under Article 34 on April 27, 2001, during the international phase of the PCT Application. It is submitted that the claims are now in proper form

***Removal of Issues Under 35 U.S.C. § 112***

Claims 1, 2 and 6 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, claims 1 and 6 and been objected to because of the underlining in the text; and claim 6 has been objected to because of the incomplete phrase "1 to 100".

In order to remove the above-noted rejection, claims 1, 2 and 6 have been corrected and provided in a form without the underlining. Claim 6 has also been corrected so as to complete the phrase such that it reads --1 to 100 carbon atoms--. It is submitted that all of the presently pending claims comply with all requirements under 35 U.S.C. § 112, such that the above-noted rejection should be withdrawn.

***Traversal of Unity of Invention Requirement***

Applicants respectfully maintain a traversal of the Unity of Invention Requirement discussed at page 2 of the Office Action of March 19, 2003. It is submitted that this Requirement is improper. First, please note that all of the presently pending claims share a "special technical feature" which is the presence of repeating units of formula

(1) and formula (2), such that the search and examination of all of the subject matter within the present claims results in no serious burden being placed on the Patent Examiner. Second, please note enclosed Exhibit A, which is page AI-71 of the Administrative Instructions under the PCT copied from the MPEP. Note that Example 18 in the "Markush Practice" section provides an example analogous to the present invention in which unity of invention is established. Despite the fact in Example 18 that substituent R<sup>1</sup> includes a wide variety of aromatic and substituted alkyl groups, unity of invention is established, since all of the claimed compounds share a common core structure as shown in the formula. Likewise, in the present situation, all of the polymer embodiments of the present invention include the combination of the repeating units of formulas (1) and (2). Consequently, it is again requested that the Unity of Invention Requirement be withdrawn.

**Issues Under 35 U.S.C. § 103(a)**

Claims 1, 2 and 6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Araki '593 (USP 5,670,593). This rejection is traversed for the following reasons.

Araki '593 discloses a copolymer formed from a monomer (A) of formula (I); and a monomer (B) of formula (II) and/or (III) as disclosed at Col. 6. The generic formula (I) of Araki '593 may overlap with formula (2) of the present invention.

Araki '593 fails to disclose a monomer of formula (1) of the present invention. In this regard, note that monomer (B) of formula (II) of Araki '593 wherein Y<sup>2</sup> is the group described at Col. 6, line 40, may be considered similar to the monomer of formula (1) of the present invention. However, this monomer of Araki '593 includes a side chain bonded to the "backbone" group "-CF<sub>2</sub>-CF-" through an oxygen atom, whereas in contrast, the monomer of formula (1) of the present invention includes a side chain bonded to a backbone group "-CH<sub>2</sub>-C-" through a -CF<sub>2</sub>- group, not an oxygen atom. Also note that backbone groups of each of these monomers are different, i.e., -CF<sub>2</sub>-C- for Araki '593 and -CH<sub>2</sub>-C- for the monomer of formula (1) of the present invention. Consequently, significant patentable distinctions exist between the claims of the present application and Araki '593, such that the above-noted rejection should be withdrawn.

It is submitted for the reasons stated above that all of the presently pending claims define patentable subject matter, such that this application should now be placed into condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

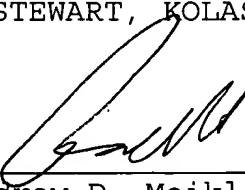
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By \_\_\_\_\_

  
Andrew D. Meikle, #32,868

P.O. Box 747  
ADM/las Falls Church, VA 22040-0747  
0020-4902P(703) 205-8000

Enclosure: Exhibit A

ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

**III. MARKUSH PRACTICE**

**Example 18— common structure:**

Claim 1: A compound of the formula:



wherein R<sup>1</sup> is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl; R<sup>2</sup>-R<sup>4</sup> are methyl, benzyl, or phenyl. The compounds are useful as pharmaceuticals for the purpose of enhancing the capacity of the blood to absorb oxygen.

In this case the indolyl moiety is the significant structural element which is shared by all of the alternatives. Since all the claimed compounds are alleged to possess the same utility, unity is present.

**Example 19— common structure:**

Claim 1: A compound of the formula:



wherein R<sub>1</sub> is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl; Z is selected from the group consisting of oxygen (O), sulfur (S), imino (NH), and methylene (-CH<sub>2</sub>-). The compounds are alleged to be useful as pharmaceuticals for relieving lower back pain.

In this particular case the iminothioether group -N=C-SCH<sub>3</sub> linked to a six atom ring is the significant structural element which is shared by all the alternatives. Thus, since all the claimed compounds are alleged to possess the same use, unity would be present. A six membered heterocyclic ring would not have been of sufficient similarity to allow a Markush grouping exhibiting unity, absent some teaching of equivalence in the prior art.

**Example 20— common structure**

Claim 1: A compound of the formula:

